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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/246,468    02/09/99    REBEK    J    TSRI-659.0

HM12/0411

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EXAMINER

GARCIA, M

ART UNIT

PAPER NUMBER

1627

5

DATE MAILED:

04/11/00

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.  
**09/246,468**

Applicant(s)

**Rebek et al**

Examiner  
**Maurie E. Garcia, Ph. D.**

Group Art Unit  
**1627**



- ☐ Responsive to communication(s) filed on \_\_\_\_\_
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire ONE month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claim

- ☒ Claim(s) 1-34 \_\_\_\_\_ is/are pending in the application.
- Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- ☒ Claims 1-34 \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- ☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

- ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☐ All ☐ Some\* ☒ None of the CERTIFIED copies of the priority documents have been
- ☐ received.
- ☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.
- ☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

- ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

- ☐ Notice of References Cited, PTO-892
- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_
- ☐ Interview Summary, PTO-413
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Notice of Informal Patent Application, PTO-152

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

### DETAILED ACTION

**Please note:** The Group and/or Art Unit location of your application in the PTO has changed. To aid in correlating any papers for this application, all further correspondence regarding this application should be directed to **Group Art Unit 1627**.

**Also Note:** In an effort to enhance communication with our customers and reduce processing time, Group 1627 is running a Fax Response Pilot for Written Restriction Requirements. A dedicated Fax machine is in place to receive your responses. The Fax number is 703-305-3704. A Fax cover sheet is attached to this Office Action for your convenience. We encourage your participation in this Pilot program. Thank you in advance for allowing us to enhance our customer service. Please limit the use of this dedicated Fax number to responses to Written Restrictions.

#### *Election/Restriction*

1. Please note that claims 23, 28, 29, 30, 31, 32 and 33 have errors in their dependency. The examiner believes that claim 23 should depend from claim 22; claim 28 from claim 27; claim 29 from claim 27; claim 30 from claim 29; claim 31 from claim 29; claim 32 from claim 31 and claim 33 from claim 27. The examiner has placed these claims into the groups below based on this assumption. Also, claims 17-21 refer to “the compound of claim 16” when claim 16 is drawn to a library. It is assumed that “the library of claim 16” is meant.
2. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-15, drawn to a compound of structure I, classified in class 548, subclass 303.4.

- II. Claims 16-21, drawn to a combinatorial library, classified in various classes depending on the compounds, for example, class 548, subclass 304.1.
- III. Claims 22-25, drawn to a process of making a combinatorial library, classified in class 436, subclass 501.
- IV. Claim 26, drawn to a specific (second) compound, classified in class 560, subclass 155.
- V. Claims 27-34, drawn to a (third) compound, classified in class 568, subclass 333.

3. The inventions are distinct, each from the other because of the following reasons:

4. Groups I, II, IV and V represent separate and distinct products. They differ in respect to their properties, their use and the synthetic methodology for making them. Therefore, they have different issues regarding patentability and enablement and represent patentably distinct subject matter. In the instant case, the library of Group II is a composition comprising at least two members, while Groups I, IV and V represent distinct molecules. Groups I, IV and V are three different compounds, all having vastly different structures.

5. Groups I and III are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case, the compounds of Group I could be

used in a materially different process, such as being used as starting materials from which other libraries (such as libraries of esters as opposed to amides) could be made.

6. Groups II and III are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case, the combinatorial libraries of Group II could be made by a different process since the amide substituents could be located on the phenyl rings and thus would not be made by the process of Group III. That is, the library of Group II could encompass compounds of different structure than those made by the process of Group III.

7. Groups IV & V are not related to Group III. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case, the process of Group III is drawn to making combinatorial libraries of compounds of a certain structure. Groups IV and V are each drawn to a compound which is not made by the process of Group III.

8. These inventions have acquired a separate status in the art as shown by their different classification and/or divergent subject matter. Please note that even though

some of these groups could be classified in the same class or subclass, this has no effect on the non-patent literature search. Different methods and products would require completely different searches in these databases, and there is no expectation that the searches would be coextensive. Therefore, this does create an undue search burden, and restriction for examination purposes as indicated is proper.

9. This application contains claims directed to patentably distinct species of the claimed invention. If applicant elects the invention of Group I, applicant is required to elect from the following patentably distinct species. **Note:** one species from each subgroup should be chosen.

Subgroup I: Species of R group

Species 1: R=H	Claim 2
Species 2: R=OR <sub>1</sub>	Claim 3

Subgroup II: Species of R<sub>2</sub> group

Species 1: R <sub>2</sub> =C <sub>6</sub> aryl	Claims 6-8
Species 2: R <sub>2</sub> =C <sub>2</sub> alkyl	Claims 9-12
Species 2: R <sub>2</sub> =C <sub>7</sub> aralkyl	Claims 13, 14

The species are distinct, each from the other, because their structures and modes of action are different. They would also differ in their reactivity and the starting materials from which they are made. Therefore, the groups have different issues regarding patentability and represent patentably distinct subject matter.

10. If applicant elects the invention of Group V, applicant is required to elect from the following patentably distinct species.

Species of R<sub>6</sub> group

Species 1: R <sub>6</sub> =H	Claim 28
Species 2: R <sub>6</sub> =C <sub>2</sub> alkyl	Claims 29-32
Species 2: R <sub>6</sub> =C <sub>7</sub> aralkyl	Claims 33, 34

The species are distinct, each from the other, because their structures and modes of action are different. They would also differ in their reactivity and the starting materials from which they are made. Therefore, the groups have different issues regarding patentability and represent patentably distinct subject matter.

11. Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable.

12. Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

13. Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

14. Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the

case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

15. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

16. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).


17. Applicant is also reminded that a 1 - month (not less than 30 days) shortened statutory period will be set for response when a written requirement is made without an action on the merits. This period may be extended under the provisions of 37 CFR 1.136(a). Such action will not be an "action on the merits" for purposes of the second action final program, see MPEP 809.02(a).

18. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Maurie E. Garcia, Ph.D. whose telephone number is (703)



308-0065. The examiner can normally be reached on Monday-Thursday from 8:30 to 6:00 and alternate Fridays.

19. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Keith Macmillan, can be reached on (703) 308-4614. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-4242. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.

  
KEITH MACMILLAN  
SUPERVISOR

Maurie E. Garcia, Ph.D.  
April 3, 2000